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09/655,743	09/06/2000	Alice H. Howe	MPH 99-46	9068

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M Paul Hendrickson
403 Main Street
P O Box 508
Holmen, WI 54636-0508

EXAMINER

CHIU, RALEIGH W

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 15

Application Number: 09/655,743

Filing Date: September 06, 2000

Appellant(s): HOWE, ALICE H.

M. Paul Hendrickson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 October 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Issues I and II listed on page 10 of the Brief are correct as they are directed to the only two rejections of record. Issues III through IX are considered to be redundant, such issues already to be addressed under 35 USC § 103.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because: (1) the arguments do not provide reasons for separate patentability for each of claims 4-15 as set forth in Groups 2-4; and, (2) the claims set forth in Group 4 have already been included in Groups 1-3.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,834,393	FELDI	05-1989
FR 2,594,037	MUSSLIN	08-1987
5,077,870	MELBYE ET AL.	01-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7, 9, 10 and 12 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 3.

Claims 8, 11 and 13-15 are rejected under 35 U.S.C. 103.

This rejection is set forth in prior Office Action, Paper No. 3.

(11) Response to Argument

Regarding claim 1, Feldi clearly discloses the recited limitations of the first seven lines. That is to say, Figure 1 of Feldi discloses the combination of a tennis racquet equipped with a ball retrieving attachment attached to the shoulder of the racquet. The Feldi ball retrieving attachment is comprised of a hooked fastener material as shown in Figures 1 and 3. Further, Figure 1 shows the fastener attached to a convex outer perimeter portion of the racquet shoulder; claim 1 of Feldi recites the fastener material as being adhesively attached. By affixing the fastener material to the tip of the racquet and touching a tennis ball, there is tangential contact and the ball is thereby engaged and lifted. Lastly, Feldi discloses an embodiment where the fastener material is made from Velcro™, an old material known to have nylon monofilament hooks. See Feldi at the bridging paragraph between columns 1 and 2. Feldi is only lacking because it is silent with respect to the dimensions of the fastener material. However, because of the Melbye disclosure that Velcro™ and Scotchmate™ were art-recognized equivalents in their use as hook-and-loop fasteners at the time of the invention, one of ordinary skill in the art would have

found it obvious to substitute Scotchmate™ for Velcro™. See Melbye at column 1, lines 15-23. Further, appellant has admitted on page 5, lines 9-17 of her specification that her claimed fastener material is a Scotchmate™ material; as such, the recited limitations of diameter and hook height would naturally be met by the Scotchmate™ substitution. Similarly, the Scotchmate™ material would naturally meet the further recited limitations of hook width, depth, diameter and density.

Although appellant states on page 18 that her device engages and lifts a grounded tennis ball upon tangential contact with the hooks and alleges that such constitutes the antithesis of what Feldi teaches and suggests to the ordinary artisan, there is no evidence to such an allegation. It should be wholly clear that in a properly intended use of the Feldi racquet, the ball would make tangential contact with the hooks of the fastener material.

Appellant further argues on pages 17-18 that there is no suggestion, teaching or motivation by Feldi that the hooked component may be used separately apart from the mating loop component. This argument is irrelevant to the extent that it is immaterial that appellant may have disclosed a further purpose or advantage for her device when the device is unpatentable over 35 USC 103. As set forth in all the Office actions, it would

have been obvious to one of ordinary skill in the art to modify the Feldi or Musslin racquets to include the Scotchmate™ material; such a racquet would inherently be able to pick up a conventional tennis ball upon tangential contact as admitted by appellant in her specification. Appellant is reminded that it has been well established that the references may suggest doing what an applicant has done even though workers in the art were ignorant of the existence of the problem.

Appellant further argues that the altered ball of Feldi is not a tennis ball and does not meet the claimed "tennis ball" requirements of Appellant's claims. First appellant does not claim a ball. Second, any ball used in tennis, can be properly considered a tennis ball.

In response to appellant's argument that there "is no basis, in fact, for the speculative conclusion that the claims do not preclude changing the tennis ball pile and the Feldi racket itself, as modified above, would inherently function as recited", it is noted that the claim language includes "comprising" language. As set forth in MPEP § 2111.03, such language can include other limitations. As such, it is maintained that the claims are broad enough to encompass changing the tennis ball pile. Moreover, it should be noted

that the modified Musslin racquet does not contemplate changing the tennis ball pile.

With respect to Musslin, Figures 2-3 clearly show tangential contact between the racket and the ball. Page 1 of the English translation discloses hooks made of a synthetic material.

Appellant further argues that Feldi teach that the hook component will not work upon tangential contact. This is not true. Feldi merely states that "it is very difficult to pick up a standard tennis ball with this system [Velcro]". See column 1, lines 18-21. Difficulty should not be confused with impossibility.

With respect to Melbye, appellant argues at length that the Melbye mushroom type hook strip is not a hooked fastener material having a series of preshrunken nylon monofilament hooks. As was noted in the previous Office rejections and here again, the Office has never taken such a position. It is undisputed that the Melbye mushroom type fastener is not a hooked fastener. Melbye is only relied upon to provide the teaching that Velcro and Scotchmate are functional equivalents with respect to fastening materials.

Appellant's statement of Facts (2-8) on pages 22-23 are not on point, and in fact, irrelevant to the rejections at issue.

Appellant (page 29) further argues on page 29 "that even if the cited prior art were deemed sufficient to establish a *prima facie* [case of, *sic*] obviousness, then the unexpected and astounding results of appellant's claimed invention would clearly rebut any such *prima facie* case of obviousness" but has shown neither unexpected nor astounding results. Mere arguments or conclusions cannot take the place of evidence. Regarding appellant's affidavit submitted 31 October 2001, the affidavit only provides conclusive evidence that the Melbye mushroom-type hooks are different from her claimed hook (essentially Scotchmate™) material, evidence never questioned by the examiner and not relevant to the instant rejections.

Regarding appellant's arguments that the features of hook height, hook width, average hook depth are neither taught nor remotely contemplated by any references relied upon in the Final rejections therein (Brief, page 31), it is noted that the Final Rejection relied on appellant's own specification showing that there exists a well-known Scotchmate™ material exhibiting such characteristics.

Appellant's argues (Brief, page 49) that the "examiner's reliance upon Melbye et al. for allegedly establishing equivalency between all fastener combinations including all Velcro™ and Scotchmate™ products is thus clearly in error" and

that the examiner deems that the appellant has admitted the equivalency of her tennis ball retrieving attachment with all other ball retriever attachments when in fact no such admission was ever made. In fact, no such claim was made and reliance is based on appellant's specification (page 7, lines 26 et seq.) which explicitly discloses that the material is a known material.

Regarding Urwin, Figures 1 and 2 teach that it is old and well-known in the art to place ball-retrieving means at either end of a tennis racquet and it should be noted that the test for obviousness is not whether the features of the reference may be bodily incorporated into another but simply what the references make obvious to one of ordinary skill in the art.

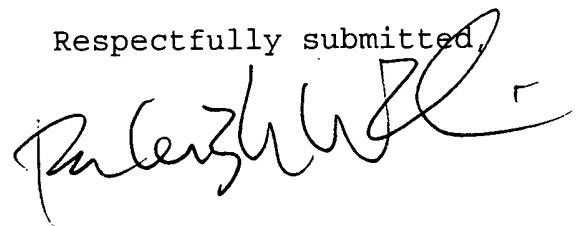
It is recognized that Feldi does not contain any disclosure concerning only hook fasteners. However, it has been established that as long as some motivation or suggestion to combine the reference is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. Therefore, the fact that one of ordinary skill following the suggestions of Melbye et al., would have provided Scotchmate™ for a different reason than appellant is not germane to the question of whether the racquet with Scotchmate™ material would have been obvious.

The suggestion and motivation is not the result of impermissible hindsight derived from appellant's own disclosure, but is based upon the prior art and the question of obviousness should be answered by looking at the teachings of the various references and determining whether they fairly suggest what appellant has done. Appellant has done no more than to select a plurality of features from the prior art and incorporate them into a unitary feature without materially altering the structure or function of each individual feature and without producing any new or unexpected result. To select features from the prior art to effect results expected from these features is within the purview of 35 USC 103.

Exhibits B and C in the Appendix have been noted for their "Exemplary [sic] listing of hook and loop product and processing patents" and Company Listings. It is further noted that the submission of the Exhibits does not comply with 37 CFR 1.97 and 1.98. Also, see MPEP § 609 and 37 CFR 1.56.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Raleigh Chiu
Primary Examiner
Art Unit 3711

RWC:dei:feif
December 23, 2002

Conferees
Paul Sewell 
Steven Wong


M Paul Hendrickson
403 Main Street
P O Box 508
Holmen, WI 54636-0508